

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Eva Maria Lanig et al.  
Appl. No.: 09/902,349  
Conf. No.: 8888  
Filed: July 10, 2001  
Title: METHOD AND APPARATUS FOR TRANSMITTING VOICE INFORMATION IN A MOBILE RADIO NETWORK  
Art Unit: 2642  
Examiner: Thjuan P. Knowlin  
Docket No.: 112740-259

Mail Stop  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**CERTIFICATE OF MAILING BY FIRST CLASS MAIL UNDER 37 CFR 1.8**

Sir:

I hereby certify that the following documents relating to the above-identified application:

1. Transmittal of Appeal Brief in triplicate;
2. Appeal Brief in triplicate;
3. Appendix A Pending Claims on 3 pages;
4. Appendix B Final Office Action on 7 pages;
5. Appendix C U.S. Patent 5,608,779 on 17 pages;
6. check in the amount of \$500.00; and
7. return receipt postcard.

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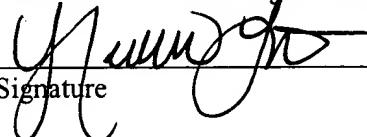
on November 16, 2005.

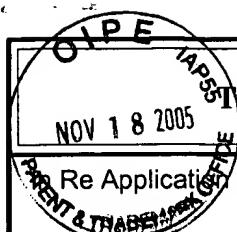
Respectfully submitted,

BELL, BOYD & LLOYD LLC

Heather Foster

Name of Person Mailing Correspondence

  
Signature

**TRANSMITTAL OF APPEAL BRIEF (Large Entity)**Docket No.  
112740-259Re Application Of: **Eva Maria Lanig et al.**

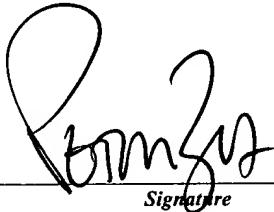
Application No. 09/902,349	Filing Date July 10, 2001	Examiner Thjuan P. Knowlin	Customer No. 29177	Group Art Unit 2642	Confirmation No. 8888
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Invention: **METHOD AND APPARATUS FOR TRANSMITTING VOICE INFORMATION IN A MOBILE RADIO NETWORK****COMMISSIONER FOR PATENTS:**

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on

The fee for filing this Appeal Brief is: **\$500.00**

- A check in the amount of the fee is enclosed.
- The Director has already been authorized to charge fees in this application to a Deposit Account.
- The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. **02-1818**
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**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

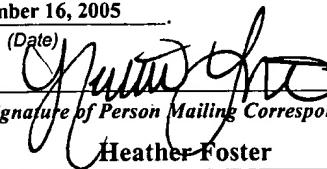
Signature

Dated: **November 16, 2005****Peter Zura (Reg. No. 48,196)  
Customer No. 29177**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

November 16, 2005

(Date)

  
Signature of Person Mailing Correspondence**Heather Foster**

Typed or Printed Name of Person Mailing Correspondence

cc:



THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Eva Maria Lanig et al  
Appl. No.: 09/902,349  
Conf. No.: 8888  
Filed: July 10, 2001  
Title: METHOD AND APPARATUS FOR TRANSMITTING VOICE  
INFORMATION IN A MOBILE RADIO NETWORK  
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Examiner: Thjuan P. Knowlin  
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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPEAL BRIEF**

Sir:

Appellants submit this Appeal Brief in support of the Notice of Appeal filed on September 16, 2005. This Appeal is taken from the Final Rejection dated June 16, 2005, which is attached as Appendix B.

**I. REAL PARTY IN INTEREST**

The real party in interest for the above-identified patent application on appeal is Siemens Aktiengesellschaft, by virtue of an Assignment dated August 17, 1999 and recorded at the United States Patent and Trademark Office at reel 12430, frame 635-637.

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## **II. RELATED APPEALS AND INTERFERENCES**

Appellants, Appellant's legal representative and the Assignee of the above-identified patent application do not know of any prior or pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision with respect to the above-identified Appeal.

### **III. STATUS OF CLAIMS**

Claims 1-11 are pending in the above-identified patent application, with claims 1, 8 and 11 being independent claims. Claims 1-11 stand rejected. Accordingly, Claims 1-11 are being appealed in this Brief. A copy of the appealed claims is attached as Appendix A.

**IV. STATUS OF AMENDMENTS**

No amendments were made in this application after the final rejection.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The present claims generally relate to an apparatus and method for transmitting voice information through the core network of a mobile radio network, between connected core networks of mobile radio networks, and from mobile radio networks to wire-bound users of a PSTN (specification page 1, lines 7-10). Specifically, the claims recite a processing apparatus and a transmitting apparatus, where an event, such as a planned conference, announcement, interception, etc., triggers a conversion of bits of voice information in the mobile radio network into a transcoded format. The converted bits are further processed to incorporate the event into the voice information data. Using the example provided above, voice data of conference partners may be mixed for a planned conference, announcements may be mixed with bits of voice information for playing announcements, voice data for an interception may be duplicated and mixed, and so on (specification, page 3, line 29 – page 4, line 6). Once the bits are processed to incorporate the event into the voice information data, they are subsequently converted into a non-transcoded format and transmitted (specification page 4, lines 6-8).

Although specification citations are given in accordance with C.F.R. 1.192(c), these reference numerals and citations are merely examples of where support may be found in the specification for the terms used in this section of the Brief. There is no intention to suggest in any way that the terms of the claims are limited to the examples in the specification. As demonstrated by the references numerals and citations below, the claims are fully supported by the specification as required by law. However, it is improper under the law to read limitations from the specification into the claims. Pointing out specification support for the claim terminology as is done here to comply with rule 1.192(c) does not in any way limit the scope of the claims to those examples from which they find support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In short, the references numerals and specification citations are not to be construed as claim limitations or in any way used to limit the scope of the claims.

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1-11 stand rejected under 35 U.S.C. §102(b) as being anticipated by *Lev et al.* (U.S. Patent No. 5,608,779). A copy of *Lev* is attached as Appendix C.

## VII. ARGUMENT

### A. LEGAL STANDARDS

#### 1. Anticipation under 35 U.S.C. §102

Anticipation is a factual determination that “...requires the presence in a single prior art disclosure of each and every element of a claimed invention.” *Lewmar Marine, Inc. v. Barent, Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Moreover, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (*emphasis added*).

Federal Circuit decisions have repeatedly emphasized the notion that anticipation cannot be found where less than all elements of a claimed invention are set forth in a reference. *See, e.g. Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364 (Fed. Cir. 2002). In this regard, a reference disclosing “substantially the same thing” is not enough to anticipate. *Jamesbury Corp. v. Litton Indust. Prod., Inc.*, 756 F.2d 1556, 1560 (Fed. Cir. 1985). A reference must clearly disclose each and every limitation of the claimed invention before anticipation may be found.

Further, anticipation cannot be shown by combining more than one reference to show the elements of the claimed invention. *In re Saunders*, 444 F.2d 599 (C.C.P.A. 1971). All elements of a claimed invention must be disclosed in one, solitary reference. As such, it is clear that a reference cannot be utilized to render a claimed invention anticipated without identical disclosure.

**B. THE REJECTION UNDER 35 U.S.C. §102(B) IS IMPROPER BECAUSE *LEV ET AL.* DOES NOT ANTICIPATE THE CLAIMED INVENTION**

In the Final Office Action, Claims 1-11 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Lev et al.* (US Patent 5,608,779). Appellants submit this rejection is improper and should be reversed.

Specifically, *Lev* does not teach “converting the voice information, dependent on an event, in the mobile radio network into a transcoded format; processing the voice information further to incorporate the event into voice information data; and converting the voice information into a non-transcoded format” as recited in claim 1, and similarly recited in claims 8 and 11.

*Lev* discloses a GSM architecture where external transcoding equipment (121-123) transmits PCM coded speech data between switches (col. 3, lines 45-62). *Lev* teaches that the switching center and the transcoders communicate in a non-compressed format, while the mobile units transceive information in the form of compressed digital voice (col. 3, lines 45-62). Depending on the operating mode (transcoding, transparent), the site controller or switching center knows to convert compressed data to non-compressed data, and vice-versa (col. 5, lines 13-43). However, *Lev* does not disclose processing the voice information further to incorporate the event into voice information data, and converting the voice information into a non-transcoded format. While the Office Action has interpreted “event” in *Lev* as meaning operating mode, this interpretation does not match the features recited in the present claims. As the present claims require incorporating/importing of the event into the voice data itself, this feature is not taught nor suggested by *Lev*. It is noted that, in this regard, claim 11 (see also claim 2), recites that the event features are further defined as a request for importing announcement data, tone data or other data into the transmitted voice information. These features are clearly not taught nor suggested by *Lev*.

Regarding the Examiner’s Response to Arguments, contained in the Final Office Action, the Examiner alleged that *Lev* disclosed processing the voice information to incorporate the event into voice information data (col. 1, lines 15-27, col. 5, lines 44-55 and col. 6, lines 18-30); and converting the voice information into a non-transcoded format (col. 3, lines 45-62 and col. 5, lines 13-43). Applicants submit that upon closer examination, the passages disclose nothing of

the sort, and merely describe the conversion-operation of the transcoders depending on the operating mode, discussed above. *Lev* explicitly teaches that the switching center (101) determines when calls originated by mobile units (116-117) are intended for other mobile units (116-117) to control the operating mode of the transcoders (121-123). When a mobile-to-mobile call is detected, the required transcoders (121-123) are instructed to operate in a transparent mode, and compressed digital audio is essentially passed through the transcoders without conversion, thereby eliminating double format conversions. When necessary, the transcoders (121-123) can also operate in a transcoding mode (i.e., compressed digital audio is converted in to non-compressed digital audio and vice versa) (col. 4, lines 11-22). The passages cited in the Response to Arguments merely details a mobile-to-mobile embodiment, where the switching center (101) instructs a transcoder to pass compressed or non-compressed signals, depending on the target unit and detected operating mode.

For the reasons discussed above, *Lev* fails to teach, suggest, or even disclose all the elements in the present claims, and thus, fails to anticipate the present claims. Accordingly, Appellants respectfully submit that claims 1-11 are in condition for allowance.

### VIII. CONCLUSION

Appellants respectfully submit that claims 1-11 are not anticipated and non-obvious in view of the cited art. Accordingly, Appellants respectfully submit that the rejection of pending claims 1-11 is erroneous in law and fact and should be reversed by this Board.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY



Peter Zura

Reg. No. 48,196

Customer No.: 29177

Phone: (312) 807-4208

Dated: November 16, 2005

**APPENDIX A**

**PENDING CLAIMS ON APPEAL OF**  
**U.S. PATENT APPLICATION SERIAL NO. 09/902,349**

Claim 1. (previously presented): A method for transmitting voice information through a mobile radio network, the method comprising the steps of:

converting the voice information, dependent on an event, in the mobile radio network into a transcoded format;

processing the voice information to incorporate event into voice information data;

converting the voice information into a non-transcoded format; and

transmitting the voice information in the non-transcoded format.

Claim 2. (previously presented): A method for transmitting voice information through a mobile radio network as claimed in claim 1, wherein the event is an intended importing of one of announcements, tones, and other information into a conversation represented by the transmitted voice information, wherein the step of processing includes importing the one of announcements, tones, and other information into the conversation by a mixing device, and wherein the step of transmitting includes transmission in a core network of the mobile radio network.

Claim 3. (previously presented): A method for transmitting voice information through a mobile radio network as claimed in claim 1, wherein the event is one of an intended handover in the mobile radio network, and an intended handover to another mobile radio network.

Claim 4. (previously presented): A method for transmitting voice information through a mobile radio network as claimed in claim 1, wherein the event is an intended duplication of the voice information for a legal tapping process.

Claim 5. (previously presented): A method for transmitting voice information through a mobile radio network as claimed in claim 1, wherein the step of transmitting occurs from a radio network controller to one of another radio network controller of the mobile radio network and a gateway into another network.

Claim 6. (previously presented): A method for transmitting voice information through a mobile radio network as claimed in claim 1, wherein the conversions are initiated by a feeding device in a media gateway of the mobile radio network.

Claim 7. (previously presented): A method for transmitting voice information through a mobile radio network as claimed in claim 3, wherein, in the case of the event being a handover in the mobile radio network, co-heard user plane information is handed over to a new radio network controller that is not yet actively switched in order to enable an interruption-free changeover during the handover.

Claim 8. (previously presented): An apparatus for transmitting voice information through a mobile radio network, comprising:

- a conversion device;
- a part for processing; and
- a transmission part;

wherein the voice information, dependent on an event, is converted via the conversion device into a transcoded format, is further processed via the part for processing, is again converted in the conversion device into a non-transcoded format, and is transmitted by the transmission part, in the non-transcoded format, via an interface to one of another media gateway and switch.

Claim 9. (previously presented): An apparatus for transmitting voice information through a mobile radio network as claimed in claim 8, wherein the apparatus includes a media gateway.

Claim 10. (previously presented): An apparatus for transmitting voice information through a 3G mobile radio network as claimed in claim 8, further comprising one of a mixing device and a driving part for driving the mixing device for mixing the voice information in the transcoded format with one of announcements, tones and other information.

Claim 11. (previously presented): A method for transmitting voice information through a mobile radio network, the method comprising the steps of:

detecting if there is a request for importing announcement data, tone data or other data into the transmitted voice information;

converting the voice information in the mobile radio network into a transcoded format when said request is detected;

processing the voice information and importing the requested data into the conversation by a mixing device;

converting the voice information into a non-transcoded format; and

transmitting the voice information in the non-transcoded format through a core network of the mobile radio network.

**APPENDIX B**

**Final Office Action Mailed on June 16, 2005**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,349	07/10/2001	Eva Maria Lanig	112740-259	8888
29177	7590	06/16/2005		
BELL, BOYD & LLOYD, LLC			EXAMINER	
P. O. BOX 1135			KNOWLIN, THJUAN P	
CHICAGO, IL 60690-1135			ART UNIT	PAPER NUMBER
			2642	

DATE MAILED: 06/16/2005

**DUE: 9/16/05**

Please find below and/or attached an Office communication concerning this application or proceeding.

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BELL, BOYD & LLOYD  
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## Office Action Summary

Application No.	09/902,349	Applicant(s)	LANIG ET AL.
Examiner	Thjuan P. Knowlin	Art Unit	2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 10 February 2005.  
2a) This action is FINAL.      2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-11 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) \_\_\_\_\_ is/are allowed.  
6) Claim(s) 1-11 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on 10 February 2005 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's amendment filed on February 10, 2005 has been entered. Claims 1-10 have been amended. No claims have been cancelled. Claim 11 has been added. Claims 1-11 are now pending in this application, with claims 1, 8, and 11 being independent.

***Claim Rejections - 35 USC § 102***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lev et al (US 5,608,779).

4. In regards to claims 1 and 11, Lev discloses a method for transmitting voice information through a mobile radio network (Fig. 2 and communication system 100), the method comprising the steps of: converting the voice information, dependent on an event, in the mobile radio network into a transcoded format (See Abstract); processing the voice information to incorporate event into voice information data (col. 1 lines 15-27, col. 5 lines 13-26, col. 5 lines 44-55, and col. 6 lines 18-30); converting the voice information into a non-transcoded format; and transmitting the voice information in the non-transcoded format (col. 3 lines 45-62 and col. 5 lines 13-43).

5. In regards to claims 2 and 10, Lev discloses a method for transmitting voice information through a mobile radio network, wherein the event is an intended importing of one of announcements, tones, and other information into a conversation represented by the transmitted voice information, wherein the step of processing includes importing the one of announcements, tones, and other of information into the conversation by a mixing device (conference bridge), and wherein the step of transmitting includes transmission in a core network of the mobile radio network (col. 6 lines 18-25, col. 10-11 lines 64-22, and col. 7-8 lines 54-7).

6. In regards to claims 3 and 4, Lev discloses a method for transmitting voice information through a mobile radio network, wherein the event is one of an intended handover in the mobile radio network, and an intended handover to another mobile radio network (col. 10 lines 29-57).

7. In regards to claims 5 and 7, Lev discloses a method for transmitting voice information through a mobile radio network, wherein the step of transmitting occurs from a radio network controller (first site controller 206) to one of another radio network controller (second site controller 207) of the mobile radio network and a gateway into another network (col. 10 lines 14-28).

8. In regards to claim 6, Lev discloses a method for transmitting voice information through a mobile radio network, wherein the conversions are initiated by a feeding device in a media gateway of the mobile radio network (col. 4 lines 11-28 and col. 5 lines 27-55).

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9. In regards to claims 8 and 9, Lev discloses an apparatus for transmitting voice information through a mobile radio network, comprising: a conversion device (transcoder 221); a part for processing; and a transmission part; wherein the voice information, dependent on an event, is converted via the conversion device into a transcoded format, is further processed via the part for processing, is again converted in the conversion device into a non-transcoded format (col. 3 lines 45-62 and col. 5 lines 13-43), and is transmitted by the transmission part, in the non-transcoded format, via an interface to one of another media gateway and switch (second switching center 202) (col. 10 lines 14-28).

***Response to Arguments***

10. Applicant's arguments filed 02/10/05 have been fully considered but they are not persuasive. Applicants argue that Lev does not teach "converting the voice information, dependent on an event, in the mobile radio network into a transcoded format; processing the voice information further to incorporate the event into voice information data; and converting the voice information into a non-transcoded format." Examiner respectfully disagrees with this argument. Lev does disclose converting the voice information, dependent on an event, in the mobile radio network (See Fig. 2 and communication system 100) into a transcoded format (See Abstract); processing the voice information further to incorporate the event into voice information data (See col. 1 lines 15-27, col. 5 lines 13-26, col. 5 lines 44-55, and col. 6 lines 18-30); and converting

the voice information into a non-transcoded format (See col. 3 lines 45-62 and col. 5 lines 13-43).

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

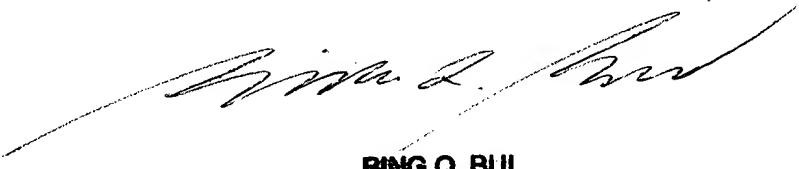
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thjuan P. Knowlin whose telephone number is (571) 272-7486. The examiner can normally be reached on Mon-Fri 8:30-5:00pm.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2642

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thjuan P. Knowlin



**BING Q. BUI**  
**PRIMARY EXAMINER**

## APPENDIX C

### U.S. Patent No. 5,608,779 (“Lev et al.”)